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21 UNITED STATES DISTRICT COURT
22 NORTHERN DISTRICT OF CALIFORNIA
23 SAN FRANCISCO DIVISION

24 ORACLE AMERICA, INC.
25 Plaintiff,
26 v.
27 GOOGLE INC.
28 Defendant.

Case No. CV 10-03561 WHA
**ORACLE'S OPPOSITION TO GOOGLE'S
MOTION IN LIMINE RE EXPERT
TESTIMONY OF DISPUTED FACTS**
Trial: May 9, 2016, 8:00 a.m.
Dept.: Courtroom 8, 19th Floor
Judge: Honorable William Alsup

INTRODUCTION

In an attempt to avoid the implications of its own documents, Google takes issue with Oracle's experts relying on those documents and other record evidence in informing their opinions and analyses as required by *Daubert*. Google seeks to exclude portions of the reports of four Oracle experts because, according to Google, they (1) "opine as to inferences to be drawn from evidence" by speaking to an entity's subjective intent or (2) "present a specific partisan version of facts *as his or her expert opinion*." Mot. at 3 (emphasis added). But Oracle's experts do not speak to any person or entity's state of mind, nor do they offer any facts—partisan or otherwise—as their expert opinion. Instead, in *every single paragraph* with which Google takes issue, the experts base their opinions on foundational record facts (accompanied by citations to the record evidence) and sometimes summarize those record facts when explaining their opinions or conducting their expert analysis.

Daubert requires experts to base their opinions on evidence—Google has, in fact, moved to exclude Oracle's experts for purportedly failing to do so. Having previously complained that Oracle's experts relied on too few facts, Google now complains that Oracle's experts have relied too much on too many. The gravamen of Google's motion is, first, that experts cannot bypass the laws of evidence by presenting facts as opinion, an issue this Court addressed at length in *Therasense, Inc. v. Becton, Dickinson & Co.*, No. C 04-02123 WHA, 2008 WL 2037732, at *4 (N.D. Cal. May 12, 2008) ("*Therasense I*"). As explained below, nothing comes close to that here. In accord with *Therasense I*, Oracle's experts "point" to the evidence on which they base their expert opinions—nothing more. *Id.* Second, Google argues, experts cannot bypass the role of the factfinder by telling the jury how it should understand evidence, an issue this Court also addressed, this time in *Therasense, Inc. v. Becton, Dickinson & Co.*, No. C 04-02123 WHA, 2008 WL 2323856, at *2 (N.D. Cal. May 22, 2008) ("*Therasense II*"). As explained below, this is not happening either. Oracle's experts do not and will not tell the jury what they should think about evidence nor opine on any entity or person's subjective state of mind.

I. PROF. KEMERER'S OPINIONS PROCEED IN THE TRADITIONAL AND CORRECT WAY

Google seeks to exclude certain of Prof. Kemerer's opinions because, according to Google, he purportedly (1) opines on Google's or others' "state of mind" and (2) constructs a narrative of facts—without expert analysis—that favors Oracle's interpretation of the record. Mot. at 4. Google's arguments are meritless.

Prof. Kemerer has 30 years' experience teaching and conducting research regarding software measurement and metrics and the economics of software at institutions such as MIT. *See* Kemerer Op. Rpt. App'x B. He is currently jointly appointed at the Katz Graduate School of Business (in Information Systems) and the School of Information Sciences at the University of Pittsburgh, and serves as a professor of Software Engineering at Carnegie Mellon University. *See id.* Based on his extensive experience and expertise in software economics and metrics, Prof. Kemerer offers four primary opinions. These four opinions *do not* rely on divining any person or entity's subjective state of mind, and every single fact in his reports that Google takes issue with serves as an assumed basis for these four expert opinions.

First, Prof. Kemerer opines about the business advantages a company in Google's position could gain from copying the 37 Java API packages. This opinion is based on his examination of record evidence related to the smartphone market, including licensing schemes. Kemerer Op. Rpt. ¶¶ 61-94, 160-82; Kemerer 2d Rpt. ¶¶ 106-117. Prof. Kemerer summarizes this record evidence in statements like "Google needed to develop a mobile platform quickly."¹ *See* Mot. at 4. This analysis of the smartphone market does not require him to determine Google's or anyone else's actual state of mind. *See Pension Comm. of Univ. of Montreal Pension Plan v. Banc of America Secs., LLC*, 691 F. Supp. 2d 448, 467 (S.D.N.Y.2010) (expert may opine on "what investors would customarily assume" so long as he "refrains from opining on the actual state of mind of the Plaintiffs"); *Therasense I*, 2008 WL 2037732, at *4 (when experts "point to evidence

¹ Each example Google cites of Prof. Kemerer supposedly opining as to corporate intent is, upon closer examination, merely his summary of record evidence. *See, e.g.,* Kemerer Op. Rpt. p. 56, Heading B ("Google Recognizes that Android is Incompatible with Java") (quoted by Mot. at 5 n.2). And, as described more fully below, Prof. Kemerer consistently cites this record evidence in service of his expert opinions.

bearing on these issues, such as a deposition admission or smoking-gun memo to file,” this is not speaking to subjective intent and knowledge); *Georges v. Novartis Pharm. Corp.*, No. CV 06-05207 SJO VBKX, 2013 WL 5217198, at *15 (C.D. Cal. Apr. 4, 2013) (expert with knowledge about scientific information available at the time could offer opinions on the adequacy of drug labels, which is not opining on corporate intent); *Deutsch v. Novartis Pharm. Corp.*, 768 F. Supp. 2d 420, 443 (E.D.N.Y. 2011) (same). Instead, the jury can decide for itself whether the foundational facts themselves speak to the state of mind.²

Nor is Prof. Kemerer merely parroting facts about the smartphone market without accompanying expert analysis. Prof. Kemerer seeks to use his experience and expertise in software measurement and management, and the economics of software adoption and markets, to aid the jury in understanding the importance of the 37 Java API packages to Google’s Android platform. He arrives at his opinions through consideration of market conditions, which requires him to identify and discuss record documents and facts, such as software licenses, and to describe how companies developed, protected, used, and monetized software during the time period relevant to this case. As one example, Prof. Kemerer cites extensive record evidence (Op. Rpt. ¶¶ 65-94) to show how the general “feedback loop of API stability”—a phenomenon he has observed during his 30 years of “studying the adoption of software process innovations and the measurement of object-oriented software” (*id.* ¶¶ 62-64)—was manifest in this particular case.

Forming opinions in his area of expertise based on foundational facts is the “traditional and correct way to proceed”; it is *not* offering partisan facts *as* his opinion. *Therasense II*, 2008 WL 2323856, at *2 (experts offer opinions “on the assumption that the foundational fact is accepted by the jury”). The jury is free to accept or reject these foundational facts, and if Google believes Prof. Kemerer relies only on favorable facts while ignoring unfavorable ones—which he does not—it may address this on cross examination. *See Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579, 587, 596 (1993) (Rule 702 codifies a liberal admissibility standard; “[v]igorous cross-examination” and “presentation of contrary evidence” are traditionally used to attack weak

² At trial, Prof. Kemerer will *not* offer any opinion as to any person or entity’s actual state of mind.

1 testimony). Oracle's experts should not be penalized merely because there is so much
2 documentary evidence that is adverse to Google.³

3 Prof. Kemerer's other three opinions—which are based on empirical analyses—are
4 equally orthodox. To arrive at his second primary opinion, he conducts an empirical analysis of
5 the copied APIs to quantify their stability. Based on this analysis, he concludes that the copied
6 API packages gave Android greater stability earlier, attracting developers to write apps, which
7 attracted consumers to Android, which then attracted more developers. Kemerer Op. Rpt. ¶¶ 96-
8 125; Kemerer 2d Rpt. ¶¶ 78-105.⁴ Third, Prof. Kemerer assesses empirically the centrality of the
9 copied Java API classes by comparing how often they are called upon by other classes as
10 compared to non-copied classes, and opines that the copied classes play a highly valuable role in
11 Java and in Android. Kemerer Op. Rpt. ¶¶ 141-157; Kemerer 2d Rpt. ¶¶ 28-51. Finally, Prof.
12 Kemerer worked with Oracle's other technical expert, Prof. Schmidt, to analyze and detail the
13 numerous ways in which Android is incompatible with Java—in particular the 37 API packages
14 at issue. *See* Kemerer Op. Rpt. ¶ 217; *see also id.* ¶¶ 183-220. Conducting such empirical
15 analyses to come to an opinion, and pointing out record documents that inform and corroborate
16 this opinion, is the quintessential role of an expert. *See Therasense I*, 2008 WL 2037732, at *4;
17 *Therasense II*, 2008 WL 2323856, at *2. Again, Google is free to cross examine Prof. Kemerer
18 about the facts on which he does or does not rely, and the jury is free to accept or reject those
19 foundational facts.

20 **II. PROF. JAFFE'S AND MR. MALACKOWSKI'S OPINIONS PROCEED IN THE** 21 **TRADITIONAL AND CORRECT WAY**

22 Google attacks the opinions of Oracle's experts Prof. Jaffe and Mr. Malackowski for the
23 same reasons it attacks the opinions of Prof. Kemerer. *See* Mot. at 6-8. Google's arguments fail
24

25 ³ Had Prof. Kemerer not recited the foundational facts on which his opinions are based, Google
26 no doubt would have sought to exclude his opinions on that basis, as it attempted to do with other
27 Oracle experts. *See, e.g.*, ECF 1565 (Google MIL #6 re Malackowski) (seeking to exclude Mr.
28 Malackowski because he purportedly conducts no analysis in support of his causal claim).

⁴ Google's assertion that Prof. Kemerer's opinion that the Java APIs were "'critical to getting
Android to market quickly' is based *solely* on his interpretation of witness testimony and
documents" is therefore demonstrably false. *See* Mot. at 4 (emphasis added).

1 for the same reasons. These experts' opinions do not rely on divining the state of mind of persons
2 or entities, nor do they merely parrot partisan record facts without expert analysis.

3 Prof. Jaffe, an economist, offers an expert opinion on whether and to what degree
4 Google's copying of the 37 Java API packages was commercial, whether or not Google's use was
5 transformative based on a market substitution analysis, whether and to what degree Google's use
6 resulted in market harm to Java SE 1.4 and 5.0 and derivatives thereof, and whether these factors
7 weigh in favor or against fair use. Contrary to Google's assertion, he does *not* recite "90 pages of
8 background facts"—putting "Oracle's spin on Google documents"—without tying those facts to
9 an "expert analysis." Mot. at 6-7. In service of his fair use opinions, Prof. Jaffe comprehensively
10 examines record documents to illustrate how the economic concepts of network goods and
11 platform economics apply in this particular case. Jaffe Op. Rpt. ¶¶ 32-94. Also in service of his
12 fair use opinions, he reviews documents and testimony to analyze the parties' business models, as
13 well as the evolution of the mobile phone market. *Id.* ¶¶ 95-188. This background is *critical* to
14 his fair use opinions, *see id.* ¶ 195 ("Using the economic framework described above, in this
15 section I analyze the purpose and character of Google's use of the Java API packages and find
16 that this factor weighs against fair use."), which are fact intensive and *require* an understanding of
17 the purpose and nature of Google's use of the 37 Java API packages as well as any market harm
18 suffered as a result of that use. *See Salinger v. Colting*, 607 F.3d 68, 81 (2d Cir. 2010) (fair use
19 arguments are "often sophisticated and fact-intensive, and must be crafted with a good deal of
20 thought and effort") (citation omitted). Nothing about this is "Oracle's lawyers speaking through
21 an expert." Mot. at 7. Rather, Prof. Jaffe's opinions will aid the jury in understanding the
22 economic aspects of fair use. Finally, Prof. Jaffe *does not* speak to any person or entity's state of
23 mind; the only paragraphs Google accuses are *summaries* of record facts. Mot. at 6 (citing Jaffe
24 Op. Rpt. ¶¶ 10, 11).⁵

25 Mr. Malackowski's opinions on damages are equally valid. Google avers that Mr.

26 ⁵ If Prof. Jaffe had not delved into the record evidence as he did, Google no doubt would have
27 complained that his fair use opinions were factually unsupported. Once again it appears that
28 Google's real beef is that the vast majority of record documents support Oracle's claims, and
Oracle's experts use these documents in formulating their opinions on these documents, as they
must.

1 Malackowski interprets “Google witness testimony and potential record evidence” about
 2 Google’s acquisition of Android, license negotiations with Sun, and the market window for
 3 mobile while relying on none of these facts for his damages analysis. Mot. at 7-8. But Mr.
 4 Malackowski, an accountant and IP licensing and damages expert, *does* rely on these foundational
 5 facts to reach his damages opinions. For example, Mr. Malackowski relies on these facts to prove
 6 a causal link between Google’s copying and Android ad revenue: if Google’s desktop search
 7 platform did not make the jump to mobile during the closing window of opportunity (as identified
 8 by Google’s own documents and witnesses), then it would miss out on a lot of money in ad
 9 revenue. *See* Malack Op. Rpt. ¶ 20 (“Several key considerations underlying my opinions are as
 10 follows: ... The opportunity, presented by infringing the Java Copyrights, to tap into the Java
 11 developer community and to more quickly get the Android platform to market during a critical
 12 ‘mobile window.’”); *id.* ¶¶ 125-26, 229-31. Also contrary to Google’s assertions (at 8), Mr.
 13 Malackowski’s causal nexus opinion relies on documents—and the empirical analysis of Prof.
 14 Kemerer—regarding how the 37 Java API packages enabled faster programming and access to
 15 more developers. *See id.* ¶¶ 225-28, 129-34. Relying on explicit statements in documents from
 16 the opposing side or on analyses of other disclosed experts to reach an opinion within one’s
 17 expertise is the “traditional and correct way to proceed,” *Therasense II*, 2008 WL 2323856, at *2,
 18 not “spoon feeding,” as Google alleges. Mot. at 8. Finally, Mr. Malackowski *does not* speak to
 19 any person or entity’s state of mind; the only paragraphs Google accuses are *summaries* of record
 20 facts. *See* Mot. at 8 n.6 (citing Malack. Reply Rpt. ¶¶ 18, 130).

21 In sum, Prof. Jaffe and Mr. Malackowski each point to the foundational facts on which
 22 they base their opinions, and their opinions do not rely on divining the state of mind of persons or
 23 entities.⁶ *See Pension Comm.*, 691 F. Supp. 2d at 467; *Therasense I*, 2008 WL 2037732, at *4;
 24 *Therasense II*, 2008 WL 2323856, at *2. Again, the jury is free to reject the foundational facts on
 25 which these experts rely, and if Google believes these experts ignore harmful facts then Google
 26

27
 28 ⁶ At trial, Prof. Jaffe and Mr. Malackowski will *not* offer any opinion as to any person or entity’s actual state of mind.

1 may take it up on cross examination. *See Daubert*, 509 U.S. 579 at 596.⁷

2 **III. THE PORTIONS OF ORACLE’S EXPERT REPORTS GOOGLE OBJECTS TO** 3 **ARE NO DIFFERENT THAN GOOGLE’S EXPERT REPORTS**

4 Google attempts to mischaracterize Oracle’s expert reports by taking statements out of
5 context to argue that they demonstrate the experts are merely reciting facts and opining on
6 subjective intent. But the same thing could be said about statements from Google’s expert
7 reports. For example, Google’s experts repeatedly speak to the intent or knowledge of persons or
8 entities, even when not summarizing evidence, *e.g.*:

- 9 • “This began when Sun made the Java language, documentation, and API
10 implementation available at no charge in 1996, apparently with the *intent* to ensure
11 that programmers throughout the industry knew and had internalized the Java
language, including these APIs,” Astrachan Op. Rpt. ¶ 158 (emphasis added);
- 12 • “Based on public statements by Sun around the time of OpenJDK’s release, the impact
13 on the market for Java by releasing OpenJDK as a free, open-source implementation
of Java SE was very much *intentional* on Sun’s part,” *id.* ¶ 266 (emphasis added);
- 14 • “Mr. Schwartz also publicly stated at the 2006 Java One conference that Sun
15 *understood and intended* that actual or potential competitors of Sun could use
OpenJDK to create products that competed with Sun’s own offerings,” *id.* (emphasis
added);
- 16 • “In 2014, Apple introduced an entirely new programming language called Swift as an
17 applications programming language for iOS devices, with the ultimate *intention* of
replacing Objective C in that role,” Leonard Op. Rpt. ¶ 119 (emphasis added);
- 18 • “All else equal, carriers *want* to offer a wide variety of handsets to appeal to a broad
19 range of customers,” *id.* ¶ 90 (emphasis added);
- 20 • “The displacement started (at least) with the iPhone and would have increased over
21 time whether or not Android existed because feature phones did not offer the product
characteristics that *end users wanted*,” Leonard 2nd Rpt ¶ 16 (emphasis added).

22 Moreover, Google’s experts base their opinions on “facts” that are contradicted by the record
23 evidence and/or Federal Circuit factual findings:

- 24 • “[T]he 37 Java SE API packages are integral to the Java programming language and
accordingly necessary to make effective use of the Java programming language,”

25 ⁷ In a footnote, Google moves to strike portions of Dr. Toubia’s expert report for opining on (1)
26 state of mind and (2) the window of opportunity, which Google declares was dictated by counsel.
Mot. at 8 n.7. Google’s contentions are meritless. Dr. Toubia will not opine on any person or
27 entity’s state of mind. Further, Dr. Toubia relies on the testimony of Android executive Andy
Rubin, not statements of counsel, for the foundational window-of-opportunity fact. Toubia Rpt.
28 ¶ 29. This foundational fact is relevant to Dr. Toubia’s criticism of the timeframe of Dr.
Simonson’s survey, which Dr. Toubia believes renders the survey irrelevant. *Id.* ¶ 34.

Astrachan Reply Rpt. ¶ 24;

- “When Google chose the Java programming language ... certain things naturally flowed from that decision—including using method declarations from the Java APIs,” Astrachan Op. Rpt. ¶ 162;
- “[T]he names and parameters of the APIs must be the same for many reasons ... the Android platform is compatible with and provided the functionality of the Java language APIs at issue, and necessarily uses the same API names and organization in order to do so,” *id.* ¶ 250;
- “I have seen no evidence that the programming that went into the allegedly copyrighted material reflects any higher level of ingenuity than the programming that went into the other parts of Android,” Leonard Op. Rpt. ¶ 198;
- “Therefore, I conclude that Google could have implemented the OpenJDK class libraries for the 37 API packages at issue starting in May 2007 and not caused any delay in the November 2007 Android announcement and release of the SDK,” *id.* ¶ 176.

In the Court’s Guidelines for Trial, the Court made clear that experts may not “vouch for the credibility of fact witnesses and/or to vouch for one side’s fact scenario.” ¶ 13. The Court’s guidelines further provide (*id.*):

Qualified experts, of course, are always welcome to testify concerning relevant scientific principles, professional standards, specialized facts known within a trade or discipline and the like. They are also welcome to apply those principles and standards to various assumed fact scenarios. This is so even if an opinion is given on the “ultimate issue.” But they should not try to vouch for one side’s fact scenario, i.e., witness believability.

Oracle’s reports were prepared with this very notion in mind. The Court again made clear in the Pretrial Order that “under no circumstance can any witness characterize someone else’s intent or willfulness (unless the witness heard the someone else admit the intent).” ECF 1760 at 7.

Orrick’s experts will follow the Court’s orders and guidelines. The Court should reject Google’s attempts to strike entirely permissible and proper expert testimony based on trumped up and incorrect claims.

CONCLUSION

For the foregoing reasons, Google’s motion should be denied.

1 Dated: May 3, 2016

Respectfully submitted,

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By: /s/ Vickie Feeman

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